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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,821	11/25/2003	Andreas Wiesmuller	1026-2	9368

7590 KENYON & KENYON LLP 1500 K Street NW Washington, DC 20005	10/09/2007
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EXAMINER
LEVINE, ADAM L

ART UNIT	PAPER NUMBER
3625	

MAIL DATE	DELIVERY MODE
10/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/722,821

Applicant(s)

WIESMULLER ET AL.

Examiner

Adam Levine

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 29-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 29-41 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 31, 2007, has been entered.

Response to Amendment

Applicants' reply filed August 31, 2007, is responsive to the office action mailed May 10, 2007, and re-mailed August 22, 2007. Applicants' are advised to attend to filing whatever papers are necessary to ensure that the powers of attorney and correspondence address are current and correct. The application records currently indicate that the power of attorney rests in attorney Edward Etkin, Esq. (Reg. No. 37,824), and the correspondence address is 228 West End Avenue, Suite A, Brooklyn, NY 11235.

The reply includes amendments to claims 1 and 6, and newly filed claims 29-41. The originally filed application contained 28 claims but omitted claim 25. It has been previously explained that claims 26-29 were renumbered by OIPE as original claims 25-28. It is this numbering that should be preserved in accordance with Rule 1.126.

Claims 16-28 have been cancelled. Claims 1-15 and 29-41 are therefore currently pending and examined in this office action.

Response to Arguments

Pertaining to rejection under 35 USC §102(b) in the previous office action

Applicants' arguments filed August 31, 2007, have been fully considered but they are not persuasive. Applicants' argue that not requiring a user to log in to the service is distinguishing. The act of logging in, or requiring a user to log in, is an additional step; an additional limitation not required by applicants' invention. It must be noted that Hudda discloses the invention as claimed. The fact that it discloses an additional limitation not required by applicants' claims is irrelevant. Applicants also point out that "The act of logging in is also described as including the supplying of authentication information." The unique confirmation code is understood to be authentication information. It is also noted that at the time of the invention the use of a wireless communication network was virtually universally known to require a user to subscribe to a network and provide authentication information to the network upon accessing it through a device, in other words, "logging in." Finally it is noted that the original specification as filed does not disclose or describe the user not logging in.

Pertaining to rejection under 35 USC §103 in the previous office action

Applicants' arguments filed August 31, 2007, have been fully considered but they are not persuasive. Applicants argue that Yamazaki does not describe "marking a

confirmation code.” Applicants’ specification describes marking a service or service code as claimed to disable the code (specification ¶¶0058-0059). The “confirmation code” in claim 12 is interpreted as referring to the “service code” described in the specification. Yamazaki describes invalidating the client identifier and/or user ID after the use of the service (see at least Yamazaki ¶¶0206-0207). These are understood as being essentially the same features.

In response to applicant's argument that Yamazaki fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., authentication information that flows from a control system to a user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Hudda clearly discloses the flow of authentication information as applicants apparently conceded in the above arguments with respect to rejection under 35 USC §102(b).

Claim Objections

Claim 30 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 30 depends from itself and is henceforth considered to depend from claim 29 for purposes of thorough examination. In addition claim 30 negates a requirement in a previous claim therefore rendering it broader than the claim from which it depends. As a result the dependent claim can be infringed without infringing the independent claim from which it depends. As a result this is an improper dependent claim even were it numbered correctly.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 26-42 been renumbered claims 25-41.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1,29,31,36 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain**

subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 36 include the limitation, "wherein the user is not logged in to the service control system during the performance of any of steps (a)-(d)." This limitation is absent from the originally filed specification.

Claim 29 includes the limitations, "wherein the control system receives the selection of the service offered via a first message sent to a first phone number associated with the control system, and wherein the unique confirmation code is sent via a second message transmitted to a second phone number associated with the user." These limitations are absent from the originally filed specification.

Claims 31 and 41 include the limitation "wherein the at least one default preference includes whether or not the control system should request identity verification prior to processing a purchase of said service." This limitation is absent from the originally filed specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 30-31,34 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 30 states, "wherein no authentication information is sent in any message." "Authentication information" is not disclosed or described in the specification. This has been interpreted as referring to confirmation information such as confirmation code, but because applicants are now negating the sending of that information the result is a dependent claim broader than the claim from which it depends. It would also appear to defeat an essential aspect of the claimed invention. Therefore the claim is indefinite.

Claims 31 and 41 recite the limitation "the at least one default preference." There is insufficient antecedent basis for this limitation in the claims. Also, claim 31 states that the "default preference includes whether or not the control system should request identity verification...". Because the limitation appears to be claiming a single default provision yet it names two mutually exclusive alternatives, it is not understood what the limitation is that is intended to be included or excluded by the claim language. This claim is an omnibus type claim.

The term "some information" in claim 34 is a relative term that renders the claim indefinite. The term "some information" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is noted that "the unique tag identifying the user as subscribing to a particular service" inherently includes "some information" linked to the unique tag identification. It is also noted that this claim contradicts the "user is not logged in," i.e., authentication information is not supplied. If "user is not logged in" were an affirmative limitation, this claim would be an improper dependent claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 1. Claims 1-11,15,29-37, and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Hudda (Paper #20060911; US Pub.No.2001/0049636).**

Hudda discloses all the limitations of claims 1-11 and 15. For example, Hudda discloses a data processing and communication method for providing commercial services over a wireless communication network to at least one user utilizing a mobile communication device configured for bi-directional communication over the wireless communication network with a service control system utilizing at least one of a short message service (SMS), or a multimedia message service (MMS) protocols. Hudda further discloses:

- at a service control system, receiving a selection of a service offered by a service provider: the service selected by at least one user in response to a trigger event, selecting by the at least one user, at least one service parameter for said service comprising at least one of grade of service and quantity of service, the control system receives the selection of the service offered via a first message sent to a first phone number associated with the control system (see at least page 4 para.0066, page 7 para.0106-0109, 0113; page 8 para.0128-0130); service

comprises at least one service selected from the following group: movies, concerts, cultural events (theater, opera, museums, performance art), sporting events, zoos, amusement parks, premium speaking engagements, travel tickets (airline, train, bus, ship), car rentals, hotel rooms, and parking (Please note: In context of the method of the invention, the name of the service is descriptive material and is not functionally involved in the recited steps. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

- confirming a purchase of said service by the at least one user: (see at least abstract, figs.3-5, page 10 para.0148)
- obtaining, by the service control system, payment for said service: from the at least one user (see at least abstract, page 5 para.0075, page 9-10 para.0143)
- transmitting a unique confirmation code: to the at least one user confirming purchase of said service, two or more different services (see at least figs.3, page 5 para.0075, 0079-0080. Please note: a single package can include two or more different services. Also, the words "good" or "goods" and "service" or "services" is used interchangeably throughout. Finally, it has been held that mere duplication of parts involves only routine skill in the art. *St. Regis Paper Co. v Bemis Co.*, 193 USPQ 8); wherein the service control system communicates with the mobile device using at least one of a short message service (SMS) protocol

and a multimedia message service (MMS) protocol (see at least page 10 para.0151); when the at least one user decides to claim said purchased service presenting said confirmation code by the at least one user to a service representative at a service claim location, verifying by the service representative using a local communication device communicating with said service control system the validity of said confirmation code, and if said confirmation code is valid providing the purchased service to the user, a unique tag identifying the user as subscribing to a particular service and having some information linked to the unique tag identification (see at least fig.3, page 3 para.0045, page 5 para.0075-0076,0079; page 9 para.0136); the unique confirmation code is sent via a second message transmitted to a second phone number associated with the user (see at least fig.3, page 2 para.0027, page 3 para.0045, page 5 para.0075, 0079-0080).

- trigger event is at least one of the following steps: providing to the service control system by the user a keyword representative of at least one offered service, user searching said service system to locate desired offered service, transmitting by the service control system to the user an offer for offered service and accepting said offer by user, selecting at least one service option by said at least one user from said at least one service option, selecting of at least one default preference for said service program (see at least figs.4,6; page 4 para.0066, 0070-0072, page 7 para.0106-0109, 0113; page 8 para.0119,0128-0130, page 10 para.0147); subscribing, by the at least one user to a service program offered by

said service provider, providing user information representative of the at least one user to the service control system (see at least figs.2-6, page 2 para.0019, page 5 para.0090, page 6 para.0100. Please note: providing representative user information as part of the subscription process is implied and inherent because in order for the user enrollment to have any meaning at all, the user must provide representative user information to the service control system); selecting of payment type by user such that payment is obtained utilizing one of said selected payment type (see at least abstract, page 2 para.0041, page 5 para.0075, page 9-10 para.0143); transmitting to the at least one user, information representative of said purchased service and instructions for claiming said purchased service (see at least figs.3, page 5 para.0075, page 5 para.0079-0080); advertising, in media or online, a keyword for specific services in order for the user to use in creating a trigger event or in selecting said service (see at least abstract, figs.2-3,7-8; page 1 para.0017, page 2 paras.0025,0031,0034-0036; page 8 paras.0126-0128); transmitting to the user a time until which the selected service is valid (see at least page 10 para.0154).

Pertaining to computer program product claims 36-37 and 39-41

Rejection of claims 36-37 and 39-41 is based on the same rationale as noted above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-14 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudda (Paper #20060911; US Pub.No.2001/0049636) in view of Yamazaki (Paper #20060911; US Pub.No.2003/0004834).

Hudda teaches all of the above as noted under the 102(b) rejection and teaches a) assigning a confirmation code to a user to indicate the user has made a purchase, b) using confirmation codes to indicate the user is authorized to receive a service, c) the user presenting the user code to a representative when claiming the service, and d) providing the service to the user upon user's presentation of the code in claiming the service. Hudda, however, does not disclose marking, at the service control system, the confirmation code as claimed to prevent future utilization of said confirmation code to claim said purchased service; downloading a database of a plurality of valid unique confirmation codes corresponding to purchased services to a local control system from a service control system, and comparing said confirmation code presented by the user to the codes at said database. Yamazaki teaches a shopping method, including an authentication unit, that a) assigns a confirmation code to a user to indicate the user has made a purchase, b) uses confirmation codes to indicate the user is authorized to receive a service, c) includes the user presenting the user code to a representative when claiming the service, and d) provides the service to the user upon user's

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presentation of the code in claiming the service. Yamazaki further teaches marking, at the service control system, the confirmation code as claimed to prevent future utilization of said confirmation code to claim said purchased service; downloading a database of a plurality of valid unique confirmation codes corresponding to purchased services to a local control system from a service control system, and comparing said confirmation code presented by the user to the codes at said database (see at least page 10 para.0191, and page 11 para.0216-0217). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Hudda to include marking, at the service control system, the confirmation code as claimed to prevent future utilization of said confirmation code to claim said purchased service; downloading a database of a plurality of valid unique confirmation codes corresponding to purchased services to a local control system from a service control system, and comparing said confirmation code presented by the user to the codes at said database, as taught by Yamazaki, in order to ensure that the user is authentic and is entitled to the service thereby greater use of the method by ensuring the reliability and security of commerce using the system.

Pertaining to computer program product claim 38

Rejection of claim 38 is based on the same rationale as noted above.

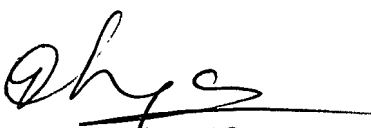
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
September 30, 2007


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